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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MARTIN & FERRARO, LLP 1557 LAKE O'PINES STREET, NE HARTVILLE, OH 44632			EXAMINER VAN HANDEL, MICHAEL P	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 09/02/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/921,096

Applicant(s)

HEADINGS ET AL.

Examiner

MICHAEL VAN HANDEL

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No.(s)/Mail Date: _____
- 4) ☐ Interview Summary (PTO-413)
Paper No.(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/11/2008 has been entered.

Response to Amendment

1. This action is responsive to an Amendment filed 6/11/2008. Claims **1-44** are pending. Claims **1, 8, 15, 22**, and **29** are amended. Claims **40-44** are new.

Response to Arguments

1. Applicant's arguments regarding the 35 USC 112, first paragraph rejection of claims **1, 8, 15, 22**, and **29**, filed 6/11/2008, have been fully considered, but they are not persuasive. See rejection below. Although the examiner disagrees with Applicant and maintains the 35 USC 112, first paragraph rejection, the examiner has provided a new grounds of rejection commensurate with Applicant's interpretation in the remarks in order to expedite prosecution.

2. Applicant's arguments regarding the Payton reference have been considered, but are moot in view of the new ground(s) of rejection.

Claim Objections

1. Claims **3, 4, 10, 11, 16-18, 23-25, 32-34** are objected to because of the following informalities:

Referring to claims **3, 10, 16, and 23**, the examiner notes that the phrase “the content usage” lacks antecedent basis. The examiner fails to find a previous recitation of content usage in the claims. The examiner recommends that the phrase be changed to “content usage” and interprets the claims in the Office Action below as though the recommended changes have been made.

Referring to claims **4, 11, 17, 24, and 32**, the examiner notes that the phrase “the viewing habits” lacks antecedent basis. The examiner fails to find a previous recitation of viewing habits in the claims. The examiner recommends that the phrase be changed to “viewing habits” and interprets the claims in the Office Action below as though the recommended changes have been made.

Referring to claims **18, 25, and 33**, the examiner notes that the phrase “the listening habits” lacks antecedent basis. The examiner fails to find a previous recitation of listening habits in the claims. The examiner recommends that the phrase be changed to “listening habits” and interprets the claims in the Office Action below as though the recommended changes have been made.

Referring to claim **34**, the examiner notes that the phrase “the amount of time” lacks antecedent basis. The examiner fails to find a previous recitation of amount of time in the claims. The examiner recommends that the phrase be changed to “an amount of time” and

interprets the claim in the Office Action below as though the recommended change has been made.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims **1-44** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claims **1, 8, 15, 22, and 29**, the examiner notes that the claimed phrase “and not determined by content preference supplied by an individual consumer in at least one group of consumers” lacks support in Applicant’s specification and is further contradicted by the dependent claims. Applicant maintains that the phrase is supported on page 3, lines 7-12 of Applicant’s specification. As noted in the Office Action mailed 1/11/2008, page 3, lines 7-12 of Applicant’s specification recites “[t]he content management system then preferably selects media content for distribution to particular groups (publishing groups) of consumers based on, for example, geographical location, bit rate service, and contract terms, and aggregates the selected media content into a rollout. A rollout is a collection of content that is available for exhibition to

consumers during a designated window of time.” The examiner still fails to find a recitation in support of “and not determined by content preference supplied by an individual consumer in at least one group of consumers” in this passage. The examiner notes that any negative limitation or exclusionary proviso in the claims must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion. As such, any claim containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. See **MPEP 2173.05(i)** for guidance. The examiner first notes that there is neither an inclusionary nor exclusionary recitation of “content preference” at all in the alleged supporting paragraph.

Furthermore, as noted in the Office Action mailed 1/11/2008, the examiner notes that the “for example” indicates that the content selection basis list is not exclusive. Still further, each of the items listed in page 3, lines 7-12 of Applicant’s specification could be construed to be consumer content preferences. That is, a consumer may desire content applicable to their geographical location, bit rate service and/or contract terms.

Applicant’s specification further recites that “[t]he receiving processor may be programmed to collect and report content usage (e.g., the amount of time the media content was viewed or listened to and consumer viewing or listening habits), and collect and report demographic data of a consumer using the media content. Such data and information may then be used to select media content to add to, supplement, or replace existing media content stored on the content database” (p. 4, lines 8-13 of Applicant’s specification). Similar language is found throughout Applicant’s specification (p. 9, lines 9-15; p. 16, lines 22-26; & p. 17, lines 1-2, 15-18). The examiner notes that consumers are directed to the content database or rollout

based on their publishing group (p. 5, lines 9-10 & p. 9, lines 3-4). As such, Applicant's specification seems to indicate that media assets are grouped based on consumer content preferences.

The examiner further notes that claims **3-5**, depending from claim 1, claims **10-12**, depending from claim 8, claims **16-19**, depending from claim 15, claims **23-26**, depending from claim 22, and claims **32-34**, depending from claim 29, recite limitations where content usage by the consumers, viewing habits of each consumer, an amount of time each consumer views content, and listening habits of each consumer, are included within the common criteria. The examiner construes at least each of these to be content preferences of an individual consumer. As such, these dependent claims appear to be contradictory to the claimed limitation of "not determined by content preference."

Further referring to claims **1, 8, 15, 22**, and **29**, the examiner fails to find support for the limitation "based on at least one common criteria of the individual consumers in the at least one group other than content preference supplied by an individual user," as currently claimed, for the reasons set forth above.

Referring to claims **41-44**, the examiner fails to find support for the phrase "the groupings are determined without collecting preferences for previously viewed content from the individual consumers in the at least one group of consumers," as currently claimed. As noted with respect to claims **1, 8, 15, 22**, and **29** above, any negative limitation or exclusionary proviso in the claims must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion. As such, any claim containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C. 112, first

paragraph as failing to comply with the written description requirement. See **MPEP 2173.05(i)** for guidance. The examiner fails to find a basis in the specification for determining the groupings “without collecting preferences,” as currently claimed.

Claims **2-7, 9-14, 16-21, 23-28, and 30-40** are rejected as being dependent on the claims addressed above.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **1-4, 6-11, 13-18, 20-25, 27-33, 35, and 37-44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Payton in view of Bryant et al.

Referring to claims **1, 8, 15, 22, 29, and 40-44**, Payton discloses a system/method for distributing digital video content, the system comprising:

- a sending processor 24 operable to distribute video content over a network to at least one storage location, the video content including a plurality of media assets and associated metadata combined into groupings, the groupings determined by at least one criteria common to the media assets (col. 4, l. 45-49, 55-58; col. 5, l. 6-28, 55-57; col. 6, l. 1-11; col. 8, l. 38-67; col. 9, l. 38-39; & Figs. 2, 6), the sending processor operable to aggregate the groupings into at least one rollout based on at least one common criteria of the individual consumers in at least one

- group (col. 5, l. 22-28; col. 9, l. 62-67; col. 10, l. 1-16; & Fig. 8), the media assets in the rollout being presented to each of the individual consumers in the at least one group (col. 9, l. 62-67 & col. 10, l. 1-8); and
- a receiving processor 176 at each storage location operable to receive the video content from said sending processor and refresh a content database 56 (local storage) based on the video content received (col. 6, l. 1-7), said content database adapted to provide the at least one group of consumers access to the video content stored therein for a predetermined interval of time having a programmed begin date and a programmed end date (Payton discloses a list that determines which items will be added to or deleted from the local storage and that the list of recommended items is updated periodically)(col. 3, l. 15-17; col. 6, l. 1-9, 63-67; col. 7, l. 1-12, 61-67; col. 8, l. 1-10, 26-36; col. 9, l. 62-67; & col. 10, l. 1-16).

Payton further discloses producing a list of recommended items for subscribers on the basis of demographic information about the subscriber (col. 5, l. 9-12). Payton does not disclose grouping media assets and consumers based on geographical location, bit rate service, or contract terms. Payton further does not disclose that the groupings are determined without collecting preferences for previously viewed content from the individual consumers in the at least one group of consumers. Bryant et al. discloses distributing programs and advertisements to targeted customer premises equipment (col. 2, l. 18, 19). Broadcast programs, including program inserts and other fills, are first generated at a studio (col. 3, l. 26-29). Bryant et al. discloses that the mix of program and advertisements to different cable operators may be different. For example, the

satellite feed to Europe may be different than the feed to Asia (col. 3, l. 29-33). Bryant et al. further discloses decoupling the base program content from the program fill and selecting and inserting program fill at head-ends and sub-heads on the basis of geographic distribution, e.g. country, municipality, street, customer premises (col. 4, l. 10-30). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the delivery system of Payton to include distributing different content to different customers on the basis of geographic location, such as that taught by Bryant et al. in order to precisely broadcast program signals to well identified target audiences (Bryant et al. col. 2, l. 10-11).

Referring to claims **2, 9, and 16**, the combination of Payton and Bryant et al. teaches the system of claims 1, 8, and 15, respectively, wherein said receiving processor is operable to refresh said content database based on the at least one common criteria of the consumers (Payton col. 8, l. 50-67; col. 9, l. 1-13; & Figs. 6, 7a, 7b).

Referring to claims **3, 4, 10, 11, 17, 18, 23-25, 32-33, and 37**, the combination of Payton and Bryant et al. teaches the systems/methods of claims 2, 3, 9, 10, 16, 22, 23, and 29, respectively, wherein the at least one common criteria of the consumers includes content usage by the consumers, and wherein the content usage includes viewing and listening habits of each consumer (Payton col. 4, l. 57-58 & col. 8, l. 38-49).

Referring to claims **6, 7, 13, 14, 20, 21, 27, and 28**, the combination of Payton and Bryant et al. teaches the systems of claims 1, 6, 9, 13, 15, 20, 22, and 27, respectively, wherein said receiving processor is operable to refresh said content database based on one or more contractual obligations associated with the content, and wherein one of the contractual obligations includes a price charged for media content access (Payton col. 7, l. 65-67 & col. 8, l. 1-5).

Referring to claim **30**, the combination of Payton and Bryant et al. teaches the system of claim 29, wherein said receiving processor is programmed to offer each consumer an extension of time before purging the media content (the examiner notes that items are added and deleted from storage according to a level of priority that is determined by user interaction with the item. Therefore, by interacting with a particular item more often, the period of time that the item is stored is extended.)(Payton col. 8, l. 26-37).

Referring to claims **31** and **35**, the combination of Payton and Bryant et al. teaches the system of claim 29, wherein said receiving processor is programmed for secured access to media content and to decrypt media content that is encrypted (Payton col. 4, l. 64-66).

Referring to claim **38**, the combination of Payton and Bryant et al. teaches the system of claim 29, wherein the media content includes media content selected by one of the consumers (Payton col. 6, l. 7-11).

Referring to claim **39**, the combination of Payton and Bryant et al. teaches the system of claim 29, wherein said receiving processor and database are located proximate a visual display accessible by one of the consumers (Payton col. 6, l. 20-23).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **5, 12, 19, 26, 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Payton in view of Bryant et al. and further in view of Eldering et al.

Referring to claims **5, 12, 19, 26, and 34**, the combination of Payton and Bryant et al. teaches the systems of claims 3, 10, 15, 23, and 29, respectively. The combination of Payton and Bryant et al. does not teach that the content usage includes an amount of time each consumer views the content. Eldering et al. discloses a system for characterizing subscribers, wherein the time duration of a user's viewing is monitored. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the combination of Payton and Bryant et al. to include monitoring a user's viewing time such as that taught by Eldering et al. in order to better provide subscribers with programming and advertising which will be of interest to them (Eldering et al. col. 1, l. 64-66).

3. Claim **36** is rejected under 35 U.S.C. 103(a) as being unpatentable over Payton in view of Eldering et al.

Referring to claim **36**, the combination of Payton and Bryant et al. teaches the system of claim 29. Payton further discloses a CD ROM writer 65, which writes a digital audio signal onto a blank CD ROM, which can then be played on a separate audio system. The combination of Payton and Bryant et al. does not teach preventing unauthorized copying of the media content. Applicant's failure to adequately traverse the Examiner's taking of Official Notice (that preventing the copying of media data is well known within the prior art) in the last Office Action is taken as an admission of the fact(s) noticed. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the combination of Payton and

Bryant et al. to prevent copying of media data, such as that taught by the admitted prior art in order to ensure that media providers are properly compensated for distributing media.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art Unit
2623

MVH